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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,668	09/19/2005	Satoru Shoshi	Q90317	3756
23373 7590 10/27/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1794				
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10/27/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,668

Applicant(s)

SHOSHI, SATORU

Examiner

ANISH DESAI

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 02/06/08 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/06/08 has been entered. Claims 1-7 are pending. Claim 5 is withdrawn from the consideration.
2. Applicant's election without traverse of Group I claims 1-4, 6, and 7 in the reply filled on 07/11/08 is acknowledged. Accordingly, claim 5 is withdrawn from consideration.
3. The 35 USC Section 103(a) rejections based on JP 2001-260549 in view of JP 11-189762 made by the previous Examiner are withdrawn in favor of a newly discovered anticipatory reference of Barrera (US 5,965,256).
4. The 37 C.F.R 1.132 affidavit/declaration filled by Mr. Satoru Shoshi is thoroughly reviewed, but it is not found persuasive. The affidavit/declaration is deficient for the reasons provided in this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Barrera (US 5,965,256).
6. Barrera teaches a surface protection film and coating. The invention of Barrera is useful as protective coatings for aircraft surfaces, automotive surfaces, signage, buildings etc. (column 1 lines 15-25, column 4 lines 2545, and column 15 lines 20-30).
7. Additionally, Barrera teaches that the surface protection film of his/her invention is formed by "(a) coating or otherwise depositing a layer comprising curable IPN [interepenetrating network] film precursors onto a cured adhesive film...applying at least one of heat and light energy...to cure the IPN film precursors and the energy-curable fluoropolymer precursor." (column 3 lines 60 to column 4 lines 1-5).
8. The aforementioned teaching of Barrera together with Barrera's disclosure at column 3 lines 43-47 and at column 4 lines 53-55 is interpreted to read on Applicant's claimed PSA sheet having a structure and composition of hard coat layer/urethane (meth)acrylate layer/PSA layer; wherein the Examiner equates Barrera's cured urethane(meth)acrylate layer and outermost layer of fluoro-containing layer with Applicant's cured urethane(meth)acrylate layer and the hard coat layer respectively. Accordingly, Barrera anticipates the presently claimed invention.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barrera (US 5,965,256).
10. Regarding claims 2 and 7, the recitation of "wherein the cured urethane(meth)acrylate layer is formed by curing difunctional urethane(meth)acrylate...or more" is directed to product by process limitation.
11. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

12. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir.1983).

13. In the instantly claimed subject matter, Applicant's FINAL product comprises a cured urethane (meth) acrylate layer that is in contact with a pressure sensitive adhesive layer. It is noted that the invention of Barrera at set forth at column 3 lines 44-47, column 3 lines 60-67 to column 4 lines 1-4 discloses of coating urethane-acrylate IPN layer on a surface of an adhesive layer, and then curing the urethane-acrylate IPN layer. Additionally, Barrera discloses of wide variety of acrylate monomers such as difunctional acrylates in formation of the IPN layer (column 8 lines20-40). Therefore, the Examiner sees no structural difference between the cured urethane (meth)acrylate layers of the FINAL product of Barrera and that of Applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 3, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera (US 5,965,256) as applied to claim 1 above, and further in view of Mori (JP 11-189762-English translation provided by the Examiner).
15. Barrera is silent as to teaching claims 2, 3, and 7. Specifically with regards to claim 3, Barrera is silent as to teaching the thickness of the cured urethane(meth)acrylate layer as claimed. Barrera discloses that the thickness of the hard coat layer is from 0.01 mm to 0.025 mm (column 14 lines 40-45), which converts to 10 micrometers to 25 micrometers.
16. However, Mori discloses an adhesive sheet substrate comprising urethane (meth) acrylate (see page 2, claim 1 and page 7, paragraph 0012 of English translation). Further, the weight average molecular weight of the urethane (meth) acrylate of Mori is from 1,000 to 10,000 (page 4, paragraph 0006 of English translation). The thickness of the adhesive sheet substrate of Mori is from 1 to 1,000 micrometers and preferably from 10 to 500 micrometers (page 13, paragraph 0027 of English translation).
17. It is noted that the primary reference of Barrera discloses a surface protection film having a urethane (meth) acrylate layer on which an adhesive layer is coated on

one surface of the urethane (meth) acrylate layer, and a hard coat layer is coated on the other surface of the urethane (meth) acrylate layer. The secondary reference of Mori discloses an adhesive sheet substrate including urethane (meth) acrylate having molecular weight in the range of 1,000 to 10,000, wherein an adhesive is coated on one side of the urethane (meth)acrylate substrate sheet.

18. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the urethane (meth) acrylate of Mori with the thickness and the molecular weight, because selecting a known material based on its suitability for its intended use establishes *prima facie* case of obviousness.

19. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera (US 5,965,256) as applied to claim 1 above, and further in view of Onozawa et al. (US 6,103,370).

20. Barrera is silent as to teaching the hard coat layer comprising filler as presently claimed.

21. However, Onozawa discloses a hard coat sheet having a base sheet, a hard coat layer provided on the base sheet, and an adhesive layer that is provided on the back of the base material (abstract and column 3 lines 60-65). Additionally, Onozawa discloses that the hard coat of his/her invention includes filler to provide anti-glare properties.

22. It is noted that the surface protection film (adhesive sheet) of Barrera is useful on the surfaces of vehicles such as automobiles, aircrafts etc. (column 15 lines 20-30).

The invention of Onozawa is useful for providing anti-scattering property and light (heat ray) shielding property to window pane in buildings, or a vehicle etc. (column 1 lines 5-15).

23. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use add the filler as taught by Onozawa in the hard coat layer of Barrera, motivated by the desire to provide anti-glare properties to the surface protective films of Barrera.

24. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barrera (US 5,965,256) alone, as evidenced by Furuya et al. (US 6,150,026); wherein Furuya is relied upon as an evidence to show that it is known to apply protective layer on the surface of a hard coat layer.

25. Barrera is silent as to teaching the protecting film laminated on the surface of the hard coat layer. However, the reference of Furuya is relied as an evidence to show that it is known to apply protective layer on the surface of a hard coat layer. Specifically, Furuya discloses a polypropylene based resin exterior panel that includes a hard coat layer, and such panels having utility in automobile industry (column 1 lines 5-20 and column 2 lines 45-50). At column 7 lines 27-35, Furuya teaches of forming of a protective film layer on the surface of the hard coat layer to protect the surface of the exterior panels from dirt, dust etc. (column 7 lines 25-30).

26. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a protective film layer on the hard coat layer of

the PSA sheet, motivated by the desire to protect the surface onto which the PSA sheet is applied from dirt and dust.

Response to Arguments

27. Applicant's arguments filed on 02/06/08 have been fully considered but they are moot in view of a new ground of rejection.

37 C.F.R. Affidavit/Declaration by Mr. Satoru Shoshi

28. While it is noted that since all of the art rejections made by the previous Examiner are withdrawn, the arguments presented in the aforementioned affidavit/declaration by Mr. Satoru Shoshi as relating to the withdrawn art rejections are moot. However, the Examiner believes that it is necessary to address the aforementioned affidavit/declaration, because it is found to be deficient for the following reasons:

- a. The affidavit/declaration fails to provide a detailed description of the experimental conditions that are used in measurement of the retardation values.
- b. The affidavit/declaration fails to provide any details on how many experimental trials were conducted to measure the retardation values, such that it becomes clear that the results obtained by Applicant are statistically significant.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. English translation of JP 15-171475 discloses a composite film and sheet, wherein the composite film comprises a urethane polymer and vinyl polymer, wherein the vinyl polymer is acrylic polymer (see page 2 of English translation).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./
Examiner, Art Unit 1794

/Hai Vo/
Primary Examiner, Art Unit 1794